



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,517	02/23/2004	Paul A. Hosier	D/A1102D	1490

7590 08/16/2005

Patent Documentation Center  
Xerox Corporation  
Xerox Square 20th Floor  
100 Clinton Ave. S.  
Rochester, NY 14644

EXAMINER

AU, BACH

ART UNIT	PAPER NUMBER
----------	--------------

2822

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

**Office Action Summary**

Application No.

10/784,517

Applicant(s)

HOSIER ET AL.

Examiner

Bac H. Au

Art Unit

2822

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/23/2005</u><br><u>2004</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Applicant is advised that should claim 6 be found allowable, claim 7 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosier (U.S. Pat. 5696626) in view of Ohtagaki (U.S. Pat. 5534443).

Regarding claims 1-2, Hosier discloses a method of making photosensitive chips for use in an imaging apparatus, comprising the steps of:

providing an integrated circuit wafer, the wafer comprising a first chip area defined in a main surface of the wafer [Col.1, lines 24-27], the first chip area including

Art Unit: 2822

structure related to a first photosite [14 of Fig.1], and a groove defined in the wafer, the groove defining at least one edge of the first chip area [32 of Fig.4A]; and dicing the wafer along the groove [40 of Fig.4A].

Hosier fails to disclose a step of providing a light-transmissive planar layer over the main surface, the planar layer forming a planar surface substantially parallel with the main surface, the planar layer extending over the groove; and the planar layer comprising acrylic. However, Ohtagaki [2a of Fig.1a; col.6, lines 12-16] discloses "A transparent planarization resin layer 2a of acrylic resin is formed on a semiconductor substrate..."

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teachings of Ohtagaki into the method of Hosier to include a step of providing a light-transmissive planar layer over the main surface, the planar layer forming a planar surface substantially parallel with the main surface, the planar layer extending over the groove; and the planar layer comprising acrylic. The ordinary artisan would have been motivated to modify Hosier in the manner set forth above for at least the purpose of providing a smooth, flat surface for obtaining desirable spectral characteristics [Ohtagaki, col.1, lines 43-47].

Regarding claims 3-7, Hosier discloses wherein:

further comprising the step of providing a filtering layer [22 of Fig. 3A].

the filtering layer extending over the first photosite [14 of Fig. 3A] and over the groove [Col.4, lines 2-30].

the filtering layer comprising acrylic [Col.1, lines 14-19].

further comprising the step of providing in the chip area a ridge defined on the main surface between the photosite and the groove [20 of Fig. 4B].

Hosier fails to disclose wherein the filtering layer is disposed over the planar layer. However, Ohtagaki [4,5,6 of Fig.1d; col.6, lines 1-6] discloses filtering layers disposed over the planar layer.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teachings of Ohtagaki into the method of Hosier to have the filtering layer disposed over the planar layer; and over the groove. The ordinary artisan would have been motivated to modify Hosier in the manner set forth above for at least the purpose of providing a smooth, flat surface, on which the filtering layer can be evenly formed, for obtaining desirable spectral characteristics [Ohtagaki, col.1, lines 43-47].


***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bac H. Au whose telephone number is 571-272-0237. The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amir Zarabian can be reached on 571-272-1852. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BHA

  
**GEORGE ECKERT**  
**PRIMARY EXAMINER**